

REMARKS / DISCUSSION OF ISSUES

Claims 1-18 are presently pending in the application. Claims 1 and 10 are the independent claims. The claims are not amended. Therefore, no listing is required under Rule 121.

Withdrawal of Holding of Abandonment

Applicants gratefully acknowledge the withdrawal of the holding of abandonment.

Rejections under 35 U.S.C. § 101

Claims 1-18 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. For at least the reasons provided below, Applicants respectfully submit that this rejection is improper and should be withdrawn.

The Office Action states that

Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-18 consist solely of capturing information simply manipulates abstract ideas without practical application in the technological arts. The language of the claims 1-18 raises a question as to whether the claimed method is directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 USC 101. Claims 1-18 is simply transferring data of program with out any significant output.

The USPTO Official Gazette Notice dated 22 November 2005, entitled "*Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*" ("the OG Notice") merely contains guidelines for patent examiners, and like the MPEP, does not have the full force and effect of law (see the OG Notice, Section I, second

paragraph). This notwithstanding, the undersigned attorney has thoroughly reviewed these guidelines and respectfully submits that the rejections of claims 1-18 are not compliant with those guidelines.

At the outset, Section IV of the OG Notice explains in detail the procedures to be followed to determine whether a claimed invention complies with the subject matter eligibility requirement of 35 U.S.C. § 101. The only references to “tangible results” in this procedure appear under Step IV(C) – “*Determine Whether the Claimed Invention Falls Within Sec. 101 Judicial Exceptions – Laws of Nature, Natural Phenomena and Abstract Ideas.*” Not surprisingly, the first thing the Examiner must do under Step IV(C) is to “*determine whether [a claim] covers either a Sec. 101 judicial exception or a practical application of a Sec. 101 judicial exception.*” Only if such a determination is made, does the analysis then proceed to determine if the claimed subject matter is nevertheless still patentable subject matter, for example, because: (1) the claim provides a physical transformation (Step IV(C)(1)(a)); or (2) the claims produces a useful, concrete, and tangible result (Step IV(C)(1)(b)).

Here, the Office Action does not even attempt to determine whether any or all of claims 1-18 cover either a Sec. 101 judicial exception (Law of Nature, Natural Phenomenon, or Abstract Idea) or a practical application of a Sec. 101 judicial exception. Rather, the claims are dismissed as abstract ideas with no analysis or explanation supporting this position.

Indeed, Applicant respectfully submits that none of the claims 1-18 cover any law of nature, natural phenomenon, or abstract idea. Claims 1-18 are all directed toward specific systems for delivering a data object to a component in a distributed network; and to specific methods for receiving a data object. These systems and methods do not cover any law of nature, natural phenomenon, or abstract idea. Accordingly, the entire analysis as to where the claims “*produce a tangible result*” is not even pertinent under the Guidelines, because the claims are not even directed to any Sec. 101 judicial exception in the first place.

Furthermore, even if any of the claims 1-18 were directed to a Sec. 101 judicial

exception, the Guidelines specifically state that this does not mean that the claim must be tied to a particular technological art, machine or environment. Furthermore, the OG Notice defines “tangible” as being the opposite of “abstract.” As such, all that is required is that the claim must set forth a practical application to produce a real-world result. Here, the claims all are practical applications producing real-world results such as transferring data objects across networks; and using multiple data type representations to deliver data objects to components in a distributed system. Accordingly, assuming *arguendo* that claims 1-18 were directed to a Sec. 101 judicial exception, the final result at the very least is a tangible result, particularly to those requiring data object transfers in networks.

Moreover, a careful review of the captioned portion of the Office Action reveals certain assertions that are irrelevant, or unintelligible, or both. For instance, the assertion that the claims ‘is simply transferring data of a program with out any significant output’ has no apparent relevance to the analysis of statutory subject matter as being an indicia of non-statutory subject matter. Furthermore, the intended meaning of the second of the portion of the Office Action reproduced above is, respectfully, indecipherable. This places Applicants in the rather precarious position of having to first determine its intended meaning, and second to address the assertion. If Applicants’ interpretation proves incorrect, their position is not properly advanced.

Accordingly, for at least these reasons, Applicants respectfully submit that the rejection of claims 1-18 under 35 U.S.C. § 101 is improper and should be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1-18 are rejected under 35 U.S.C. § 102(e) as being unpatentable over *Phillips, et al.* For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn.

i. The Office Action is improper

Claim 1 is drawn to a system for delivering a data object to a component in a distributed networks and features:

*“...a first data type representation, wherein data fields in the data object are mapped into the first data type representation;
a second data type representation; and
means for transforming the first data type representation into the second data type representation.”*

Claim 10 is drawn to a method for receiving a data object and includes similar features.

The rejection for anticipation of claims 1-18 states, *in toto*:

3. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Phillips et al. (US 2006/0129627).

Regarding claims 1-18, Phillips discloses that first and second data storage and data transfer from and to (Fig. 1 and Fig. 3), an interface receiving the data object and mapping data fields in the data object into a first data type (Fig. 2), checking if the data is not available (Fig. 8).

a. MPEP § 706

Applicants respectfully submit that the rejection fails to comply with MPEP § 706, which states, in part:

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity (emphasis added).

From a review of the rejection it is clear that not all features of either claim 1 or claim 18 have been addressed as being allegedly disclosed in the applied art. For

instance, the second data type is not even addressed in the rejection. Moreover, the dependent claims, which comprise approximately two and one-half pages of text were not addressed in the rejection and, respectfully, have not been addressed and could not have been given proper consideration in barely four lines of substantive text. As such, because the various features of the independent and dependent claims were not even addressed with in the Office Action, a clearly articulated rejection could not possibly have been made with citation to the art of each feature of every claim.

Thus, Applicants respectfully, but strongly submit that a clearly articulated rejection within the guidelines set by MPEP § 706. Therefore, the rejection of claims 1-18 for anticipation is improper and should be withdrawn. Additionally, by not being provided a clearly articulated rejection, Applicants are deprived of the earliest opportunity to provide evidence of patentability or to otherwise reply completely to the rejection. **Therefore, if the claims are rejected in future correspondence, Applicants respectfully submit that any such rejection cannot be made final.**

b. 37 CFR § 1.104(c) (2)

The rejection likewise fails to comply with 37 CFR § 1.104(c) (2), which provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified (emphasis added).

Applicants respectfully submit that the rejection of claims 1-18 for anticipation fails to comply with the noted Rule. **The reference relied upon in the Office Action comprises over 44 columns of text and 17 sheets of drawings.** Yet, only a few

drawings are even referenced in the Office Action and, as noted above, not all features of even the independent claims are addressed in the rejection, let alone the features of the 16 dependent claims. As such, Applicants are placed in the rather precarious position of having to review the applied art and attempt to discern that which the Examiner intends to anticipate the various features of the claims. This is wholly improper and renders the rejection improper as well.

Respectfully, Applicants have fulfilled the requirements to be accorded substantive examination and thus are entitled to full examination of the application. Because such examination as set forth under 37 CFR § 1.104(c)(2), has not been accorded for at least the reasons set forth above, Applicants respectfully submit that the rejection of claims 1-18 for anticipation is improper and should be withdrawn.

c. Rejections are improper

For at least the reasons set forth in i.a. and i.b., Applicants respectfully submit that the rejection of claims 1-18 is improper and should be withdrawn. Applicants do not concede that the applied art anticipates the rejected claims and reserve their right to present evidence of patentability in future replies, if necessary and proper.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Agilent Technologies, Inc.

s/William S. Francos/

by: William S. Francos (Reg. No. 38,456)

Date: February 11, 2008

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